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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,411	01/22/2004	Oliver Wendel Gamble		4909

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Oliver W. Gamble
436 East 75 Street
New York, NY 10021

EXAMINER

DAGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 11/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,411

Applicant(s)

GAMBLE, OLIVER WENDEL

Examiner

Stephen M. D'Agosta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claims 2-5 and 7-9 objected to because of the following informalities: these claims should only refer back to a claim "number" and not a claim "number and letter" (ie. claim 2 should refer back to claim "1" and not "1b"). Appropriate correction required.

2. Claims 7-9 should refer back to claim 6 and not claim 1 as written.

Specification

1. The disclosure is objected to because of the following informalities:

What is SKYRIDER? Is it a company? Should it be Trade-marked?

Is it a "prior art" design owned by another?

Please provide a response for the examiner.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "**means**" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this **invention**," "The disclosure describes," etc.

→ the words "means" and "invention" should be removed.

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3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) **TITLE OF THE INVENTION.**
- (b) **CROSS-REFERENCE TO RELATED APPLICATIONS.**
- (c) **STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.**
- (d) **THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT**
- (e) **INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC** (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) **BACKGROUND OF THE INVENTION.**
 - (1) **Field of the Invention.**
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) **BRIEF SUMMARY OF THE INVENTION.**
- (h) **BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).**
- (i) **DETAILED DESCRIPTION OF THE INVENTION.**
- (j) **CLAIM OR CLAIMS** (commencing on a separate sheet).
- (k) **ABSTRACT OF THE DISCLOSURE** (commencing on a separate sheet).
- (l) **SEQUENCE LISTING** (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

-- Please amend the specification to include the titles (in bold) in that order

Double Patenting

Claims 1-5 of this application conflict with claims 1, 2, 3, 7 and 10 of Application No. 2005/0107121. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

■ The claim equivalents are as follows:

This Application	App# 2005/0107121
○ Claim 1	Claim 1
○ Claim 2	Claim 2
○ Claim 3	Claim 7
○ Claim 4	Claim 3
○ Claim 5	Claim 10

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

Claims 1, 6 and 10 rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The claims state/infer "the interfacing will allow each device to initiate activity within the other device", yet the specification appears to only describe the wired phone connecting to the wireless network (and not the wireless phone connecting to the wired network). This is critical or essential to the practice of the invention, but not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The applicant is asked to please point out in the specification where these two connections are found.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Uchiyama US 2003/0078071 and further in view of Raffel et al. US 5,675,629.

As per **claims 1, 6 and 10**, Uchiyama teaches a method of adding an extension phone to a cell wireless telephonic device (title, abstract), comprising:

(a) Interfacing the wireless telephonic device with one or more extension phone(s) [see figures 1 and 6 which show a docking station that allows a user to use a handset that connects to either a landline or cellular link];

(b) the interfacing will allow each device to be aware of what is happening in the other device [see Para# 0011-0013. Also Para# 40 and #42 which teach using one communications link (wireless) and receiving a call on another link (ie. wired) and then either accepting the call or allowing it to be sent to the answering machine];

(c) the interfacing will allow the wired phone to transmit/receive calls via the wireless system [Uchiyama does support using the docking station to select either a wired or wireless connection -- Para# 35 teaches a Line and Cell button to select which resource to use, and specifically teaches using the wired handset to connect to a wireless link. Furthermore, "activity" (or alert) signals are passed to/from either phone to the docking station which allows the user to choose the operation they desire];

(d) Each device will coordinate activity with the other device [figure 6 shows the switching unit #72 and Controller #70 which provides coordination between the communications links, ie. wired or wireless, and the handsets];

but is silent on each device to initiate activity within the other device (ie. the wireless phone connecting to the wired system).

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Raffel teaches a cordless cellular BTS (title, abstract) that allows a cell phone to connect to it via cellular RF channels and then passes the call through to the wired phone network/PSTN (figures 1-5 and C2, L25-45).

It would have been obvious to one skilled in the art at the time of the invention to modify Uchiyama, such that each device can initiate activity within the other device, to provide means for a person to use either phone to connect with either wired or wireless links to transmit/receive calls.

As per **claims 2 and 7**, Uchiyama teaches claim 1/6, wherein extension phones will be able to detect incoming calls to the wireless telephonic device (Para#42 teaches the docking station/handset being on a landline call and alerting the user that there is an incoming wireless call).

As per **claim 3**, Uchiyama teaches claim 1, wherein the extension phone will be able to make outgoing call through the wireless telephonic device (Para#11-13 teaches using the cordless handset to make a wireless call, also see Para#35 which teaches a Line and Cell button to select which communications link to use).

As per **claims 4 and 8**, Uchiyama teaches claim 1/6, wherein the wireless telephonic device will be able to cause the extension phone **(to)** signal an incoming call (Para#13 teaches using the cordless handset to answer any of the incoming calls from either the wireless or wired communication systems. Also see Para#27. Para#42 teaches the handset receiving incoming caller ID information, which if from a wireless link, is causing the extension/cordless phone to be signaled).

As per **claims 5 and 9**, Uchiyama teaches claim 1/6, wherein monitoring can detect when an incoming call is being answered at the extension phone (Para#42 teaches a call being received and Caller ID being sent to the extension/cordless phone and then being answered, otherwise it is sent to the answering machine. Hence the system is monitoring an incoming call to determine if it has been answered or if it needs to route it to the answering machine).

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Alexis US 2004/0072544
2. Newmark US 2003/0144030
3. Fintel US 6,704,580
4. Hofman US 2002/0090919
5. Meyerson et al US 2003/0059039
6. Wonak et al US 6,778,824
7. Markowitzh US 2002/0160791
8. Lorbeck US 2003/0114135
9. Janssen et al. US 2004/0203738
10. Bacon et al US 2004/0203482
11. Byrne US 5,533,099
12. King et al US 6,275,687
13. Raith US 2002/0102974

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta
Primary Examiner

